APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,578	10/10/2001	Michael Irvin Hyman	50044.12USU1	8713

23552 7590 06/29/2004	EXAMINER	
MERCHANT & GOULD PC	NGUYEN BA, HOANG VU A	
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MINNEAPOLIS, MN 55402-0903	ART UNIT	PAPER NUMBER
	2122	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _10 October 2001_.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-20_ is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) _1-20_ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on _10 October 2001_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All b) ☐ Some * c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the application filed October 10, 2001.

2.   Claims 1-20 have been examined.

Drawings

3.   The drawings, filed October 10, 2001, are accepted by the examiner.

Specification

4.   The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

5.   The following title is suggested: "Method and System for Displaying a Graphical Representation of a Server-side Object in a Visual Development Environment."

Claim Objections

6.   Claim 16 is objected to because of the following informalities: a colon – : – should be inserted between "at least one of " and "placing an icon" at line 2.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims 8, 9, 10, 17, 18 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a.   Claim 8 recites the limitation "the visual development environment" at lines 4-5 (three occurrences). There is insufficient antecedent basis for this limitation in the claim.

b.   Claim 18 recites the limitations "the graphical representation" and "the server-side object" at line 8. There is insufficient antecedent basis for these limitations in the claim.

c.   Claims 1, 10, 18 and 20: it is unclear from which side the request for code is being made, user's side or server's side? and where exactly the graphical representation of a server-side object is to be displayed, at the user's side or at the server's side? For art rejection purposes, the request is being made at the user's side and the graphical representation of a server-side object is to be displayed at the user's side.

d.   Claims 9 and 17 recite the limitation "the graphical representation is visually similar to what is generated when an execution application requests the server-side object." First, the term "visually similar to" is vague and indefinite because one cannot ascertain the metes and bounds of the claimed limitation "graphical representation." Note that an octagon displayed on a low resolution screen is visually similar to a circle. Second, the limitation "what is generated" is also vague and indefinite. What is exactly "what is generated?"

e.   Claim 10 is vague and indefinite because:

i.   One is not absolutely certain what "a modulated data

signal" is. Is it an electrical signal? Is it permanently stored or tangibly embodied in a physical medium or it may only exist just for the duration of time it is transmitted over a communications link?

       ii.   a single claim which claims both a data signal (product?), computer-executable instructions (i.e., software) and method steps of displaying a graphical representation of a server-side object is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

In claim 10, it is unclear whether an article of manufacture or a program code or a process of displaying a server-side object is claimed. With a modulated data signal (interpreted to mean a product) recited in the preamble, one would expect to find in the body of the claim means or devices having functions to display a server-side object. However, one only found method steps for displaying a server-side object.

Correction is required.

Claim Rejections – 35 USC § 101

9.   35 U.S.C. § 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10.   Claim 10 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

A single claim which claims both a product and the method steps of using the product should also be rejected under 35 U.S.C. 101, *Ex parte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), based on the theory that the claim is directed to neither a "process" nor an "article of manufacture," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

11.   Claims 10-17 are rejected under 35 U.S.C § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 merely recites a product comprising computer-executable instructions for displaying a graphical representation of a server-side object. Computer-executable instructions are claimed matter that is descriptive material *per se*. Such non-functional descriptive material is not statutory because it is not a physical "thing" nor a statutory process as there are not "acts" being performed. Such claimed computer-executable instructions do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer's program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer's functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program's functionality to be realized, and is thus mandatory. *Warmerdam*, 33 F.d at 1361, 31 USPQ 2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106 (IV)(B)(1)(a).

Claims 11-17, which depend from claim 10, are also rejected under 35 U.S.C. § 101 for the same reasons.

Correction is required.

Claim Rejections – 35 U.S.C. § 102

12.   The following is a quotation of the appropriate paragraphs of 35 U.S.C.

§ 102 that form the basis for the rejections under this section made in this Office

action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,
> except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

13.   Claims 1-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S.

Patent No. 6,493,733 to Pollack et al. ("Pollack").

Claims 1, 10, 18 and 20

Pollack discloses at least:

(a) *upon a triggering event, requesting code that represents a user interface from a*
server (see at least Figure 8, steps 802, 804; Figure 9; and related discussion in the
specification);

(b) *deactivating at least one element in the requested code, wherein the element*
causes an action to be taken when activated (see at least 5:31-53); *and*

(c) *displaying the graphical representation of the server-side object using the*
requested code (see at least Figure 5, item 504; Figure 5A, items 504, 506; Figure 6, item
602; and related discussion in the specification).

Claims 2 and 12

The rejection of base claims 1 and 10 is incorporated. Pollack further discloses *wherein before deactivation, the element in the requested code is activated when a graphical object associated with the element is selected* (see at least 5:31-53).

Claims 3 and 14

The rejection of base claims 1, 10 and intervening claims 2, 11-13 is incorporated. Pollack further discloses *wherein the graphical object is a button or a hypertext link* (see at least 5:31-53; Figure 4, hyperlink displayed in box 406; Figures 5A and 6, button labeled "Join List"; and related discussion in the specification).

Claims 4, 11 and 19

The rejection of the base claims and intervening claims is incorporated. Pollack further discloses *changing an address of an image in the code* (see at least 5:31-53; Figure 4, hyperlink displayed in box 406; and related discussion in the specification).

Claim 5

The rejection of base claim 1 and intervening claims 2, 4 is incorporated. Pollack further discloses *wherein the address is a relative reference to a location of the image* (see at least 5:31-53; Figure 4, hyperlink displayed in box 406; and related discussion in the specification).

Claims 8 and 16

The rejection of base claims 1, 10 and intervening claims 2, 11, respectively is incorporated. Pollack further discloses *wherein the triggering event includes at least one of:*

placing an icon associated with the server-side object on a page in a visual development environment; changing a property of a control; opening a file containing a control in the visual development environment; refreshing the visual development environment; polling by the visual development environment that indicates that the server-side object is changed; and a message sent from a server indicating that the server-side object is changed (see at least Figure 8, steps 802, 804; Figure 9; and related discussion in the specification).

Claims 9 and 17

The rejection of base claims 1, 10 and intervening claims 2, 11, respectively is incorporated. Pollack further discloses *wherein the graphical representation is visually similar to what is generated when an executing application requests the server-side object* (see at least Figure 8, steps 802, 804; Figure 9; and related discussion in the specification).

Claims 6 and 15

The rejection of the base claims and intervening claims is incorporated. Pollack further discloses *wherein the code is written in a markup language* (see at least 5:31-53; Figure 4, hyperlink displayed in box 406; and related discussion in the specification).

Claim 7

The rejection of base claim 1 and intervening claim 6 is incorporated. Pollack further discloses *wherein the markup language is a hypertext markup language* (see at least 5:31-53; Figure 4, hyperlink displayed in box 406; and related discussion in the specification).

Claim 13

The rejection of base claim 10 and intervening claims 11-12 is incorporated. Pollack further discloses *wherein activating the element includes selecting a graphical object associated with the element, wherein the graphical object is a proxy in a visual development environment, wherein the proxy proxies for the server-side object* (see at least 4:62 – 6:9).

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (703) 305-0103. The examiner can normally be reached on Tuesday-Friday, 6:00 to 16:156:00 - 16:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2122

June 26, 2004

ANTONY NGUYEN-BA
PRIMARY EXAMINER